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Pawel Rej

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EXAMINER

SINGH, RACHNA

ART UNIT

PAPER NUMBER

2176

SHORTENED STATUTORY PERIOD OF RESPONSE	MAIL DATE	DELIVERY MODE
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PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

If NO period for reply is specified above, the maximum statutory period will apply and will expire 6 MONTHS from the mailing date of this communication.

DETAILED ACTION

1. This action is responsive to communications: Amendments and Remarks filed 10/31/06.

2. Claims 1-3, 5-7, 9-15, 17-19, and 21-26 are pending. Claims 1, 7, 13, 19, 25, and 26 are independent claims.

Claim Rejections - 35 USC § 112

3. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

4. Claims 1-3, 5-7, 9-15, 17-19, and 21-26 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

Independent claims 1, 13, and 25 has been amended to recite, "storing data indicating a common mark specific to the target area with each node that fits into the target area. . ." There does not appear to be any support for storing a common mark specific to a target area in the Specification. Although the specification discloses

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marking nodes that fit into a target area. The marking of a node does not signify storing a node. Appropriate correction and/or clarification is required.

Claims 2-3, 5-6, 14-18 are rejected under 35 U.S.C. 112, first paragraph, for fully incorporating the deficiencies of their base claim from which they depend.

Independent claims 7, 19, and 25 similarly recites, "storing the tree fragment". There does not appear to be any support for storing a common mark specific to a target area in the Specification. Although the specification discloses marking nodes that fit into a target area. The marking of a node does not signify storing a node. Appropriate correction and/or clarification is required.

Claims 9-12 and 21-24 are rejected under 35 U.S.C. 112, first paragraph, for fully incorporating the deficiencies of their base claim from which they depend.

Claim Rejections - 35 USC § 101

5. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

6. Claims 1-3, 5-7, 9-15, 17-19, and 21-26 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

7. Claim 1 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, marking nodes with a common mark specific to a target area does not necessarily produce a tangible result unless the structure of the input tree is either saved, stored, or displayed. The mere marking of a data structure fails to produce a tangible result.

Claims 2-3 and 5-6 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

8. Claim 7 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, generating the tree fragment from the nodes marked with a common mark does not produce a tangible result unless the tree fragment is saved, stored, or displayed. The mere generating of a data structure fails to produce a tangible result.

Claims 9-12 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

9. Claim 13 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, marking nodes with a common mark specific to a target area does not necessarily produce a tangible result unless the structure of the input tree is either saved, stored, or displayed. The mere marking of a data structure fails to produce a tangible result.

Furthermore, claim 13 is considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus. Where there is no evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. It should be noted that functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system.

Claims 14-15 and 17-18 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

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10. Claim 19 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, generating the tree fragment from the nodes marked with a common mark does not produce a tangible result unless the tree fragment is saved, stored, or displayed. The mere generating of a data structure fails to produce a tangible result.

Furthermore, claim 19 is considered software per se. Computer programs may be explicitly claimed as, for example, a series of code or instructions for performing functions or may be implicitly claimed as, for example, a system, a module or an apparatus. Where there is no evidence in the specification that a means which may be interpreted as software, hardware or combinations thereof necessarily includes hardware, it will be interpreted in its broadest reasonable sense as a software means, which is the case here.

Thus a claim to functional descriptive material, including computer programs, per se, is not patent eligible subject matter. It should be noted that functional descriptive material claimed in combination with an appropriate computer readable medium to enable the functionality to be realized is patent eligible subject matter if it is capable of producing a useful, concrete and tangible result when used in the computer system.

Claims 21-24 are rejected under 35 U.S.C. 101 for fully incorporating the deficiencies of their base claim.

11. Claim 25 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, marking nodes with a common mark specific to a target area does not necessarily produce a tangible result unless the structure of the input tree is saved, stored, or displayed. The mere marking of a data structure fails to produce a tangible result.

Furthermore, it is noted that claim 25 recites a computer program product including a computer readable medium. The claim recites functional descriptive material on a data processor-readable recording medium that can be a carrier wave (Specification, page 15). The computer readable medium must be physical structure which provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a carrier wave) are all examples of media which are not believed to enable the functionality to be realized with the computer.

12. Claim 26 is drawn to non-statutory subject matter because it fails to produce a tangible result. In order to be statutory, the claim must produce a useful, concrete, and tangible result. Specifically, generating the tree fragment from the nodes marked with a common mark does not produce a tangible result unless the tree fragment is saved,

stored, or displayed. The mere generating of a data structure fails to produce a tangible result.

Furthermore, it is noted that claim 26 recites a computer program product including a computer readable medium. The claim recites functional descriptive material on a data processor-readable recording medium that can be a carrier wave (Specification, page 15). The computer readable medium must be physical structure which provides the functional descriptive material in usable form to permit the functionality to be realized with the computer. A program product which does not explicitly include such a medium, a program per se, a signal or other type of transmission media that fails to include the hardware necessary to realize the functionality (e.g., a carrier wave) are all examples of media which are not believed to enable the functionality to be realized with the computer.

Allowable Subject Matter

13. It is noted that claims 1-3, 5-7, 9-15, 17-19, and 21-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph set forth in this Office action.

Response to Arguments

14. Applicant's amendments and remarks filed on 10/26/06 have been fully considered. Examiner has presented rejections under 35 U.S.C. 101 regarding non-statutory subject matter and 35 U.S.C. 112, first paragraph. It is noted the rejections under 35 U.S.C. 101 are maintained in view of the 35 U.S.C. 112, first paragraph rejections presented above.

It is further noted that claims 1-3, 5-7, 9-15, 17-19, and 21-26 would be allowable if rewritten or amended to overcome the rejection(s) under 35 U.S.C. 101 and 35 U.S.C. 112, first paragraph set forth in this Office action.

In view of the comments above, the rejection is maintained.

Conclusion

15. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not

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mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the date of this final action.

16. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Rachna Singh whose telephone number is 571-272-4099. The examiner can normally be reached on M-F (8:30AM-6:00PM).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Herndon can be reached on 571-272-4136. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

RS
12/26/06


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